

05-22-02

AF/1600

PATENT APPLICATION

FEE AUTHORIZATION / AMENDMENT TRANSMITTAL LETTER

Attorney's Docket No:
A-451F

Serial No. 09/211,297 Filing Date December 14, 1998 Examiner DeBerry, Regina M. Group Art Unit 164

In Re Application of
William J. Boyle

For
Osteoprotegerin Binding Proteins

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

- ☒ Applicant(s) request(s) the following extension of time under 37 CFR 1.136(a):
- ☐ One month of original due date (\$110.00)
 - ☐ Two months of original due date (\$400.00)
 - ☒ Three months of original due date (\$920.00)
 - ☐ Four months of original due date (\$1,440.00)
 - ☐ Five months of original due date (\$1,960.00)
- ☒ A response in connection with the matter for which this extension is requested:
- ☒ is filed herewith.
 - ☐ has been filed.
 - ☐ The response is the filing of a continuing prosecution application, the prior application having an express abandonment conditioned on the granting of a filing date to the continuing application.
 - ☐ The accompanying papers include amended claims for which no additional fee is required.
 - ☐ The accompanying papers include amended claims the fee for which has been calculated as follows:

CLAIMS AS AMENDED

(1)	(2) Claims remaining After amendment	(3)	(4) Highest number Previously paid for	(5) No. of Extra claims present	(6) Rate	(7) Additional Fee
Total Claims	*	Minus	** =	0	x \$18	= \$ 0.00
Indep. Claims	*	Minus	*** =	0	x \$84	= 0.00
<input type="checkbox"/> First Appearance of a multiple dependent claim					+ \$280	= 0.00
Total Additional Fee for this Amendment						\$0.00

- * If the entry in column 2 is less than the entry in column 4, write "0" in column 5.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.
The "Highest No. Previously Paid For" (Total or Indep.) is the highest number found in the appropriate box in Col 1. of a prior amendment or the number of claims originally filed.

- ☐ The following other fees are incurred by the accompanying papers.
☐ Other: _____

Please charge Deposit Account No. 01-0519 in the name of Amgen Inc. in the amount of \$ 920.00. A duplicate copy of this petition is attached.

- ☒ If an additional extension of time is required, please consider this a request therefore.
☒ The Commissioner is hereby authorized to charge any additional fees which may be required by the accompanying papers, or credit any overpayment to Deposit Account No. 01-0519.

Please Send Future Correspondence To:

US Patent Operations/RBW
Dept. 4300, M/S 27-4-A
AMGEN INC.
One Amgen Center Drive
Thousand Oaks, California 91320-1799

Robert B. Winter
Attorney/Agent for Applicant(s)
Registration No.: 34,458
Phone: (805) 447-2425
Date: May 20, 2002

EXPRESS MAIL CERTIFICATE

Express Mail mail labeling number: EL360693979US

Date of Deposit: May 20, 2002

I hereby certify that this paper or fee is being deposited with the United States Postal Service *Express Mail Post Office to Addressee* service under 37 C.F.R. 1.10 on the date indicated above and is addressed to Box AF, Assistant Commissioner for Patents, Washington, D.C. 20231.

Deb La Bass
Printed Name

Debbie La Bass
Signature

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Applicant(s): William J. Boyle

Serial No.: 09/211,297

Group Art Unit No.: 1647

Filed: December 14, 1998

Examiner: DeBerry, Regina M.

For: Osteoprotegerin Binding Proteins

Docket No.: A-451F

RESPONSE

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Office Action dated November 19, 2001 in which Claims 37-57 are rejected under 35 U.S.C. 112, first paragraph. Reconsideration and withdrawal of the rejections are requested.

REMARKS

Examiner correction under 37 CFR 1.126

Applicant acknowledges that Claims 37-47 added in Paper No. 3 dated March 25, 1999 and Claims 48-58 added in Paper No. 8 were renumbered accordingly by the Examiner in view of Applicant's inadvertent omission of Claim 43. Claims 37-57 are currently under examination.

Rejections under 35 U.S.C. 112

Claims 37-57 are rejected under 35 U.S.C. 112, first paragraph, as the specification allegedly fails to enable the claimed composition wherein the recited OPGbp comprises variants. The Examiner argues that it would require undue experimentation to generate OPGbp variants to which the claimed antibody compositions would bind. Applicants disagree.

Various criteria for determining whether experimentation is undue is set forth in *In re Wands* 8 USPQ 2d 1400 (Fed. Cir. 1988). In view of the *Wands* factors, Applicant maintains that the teachings of the

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Debra Bass

Printed Name

Debra Bass

Signature